

### REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on March 6, 2006, the Examiner rejected claims 1-20 and 23-27.

#### Interview Summary

Applicants have amended the claims in a manner consistent with the suggestions made by the Examiner during the telephonic interviews conducted on March 21 and 23, 2006. The following sections are designed to coincide with paragraphs of MPEP 713.04

- A) No exhibits were shown or conducted
- B) Claims 1-20 and 23-27 were discussed
- C) Prior art discussed: Walthall et al (US 4,305,006) and Endruschat et al. (US 5,594,238)
- D) Amendments and arguments made during the interview are contained within this and other responses filed on behalf of the Applicants.
- E) Arguments expressed by the Applicants are properly summarized in the series of amendments and responses sent to the Examiner.
- F) No other pertinent matters discussed

#### Rejections under 35 U.S.C. § 112

In the Office Action, the Examiner rejected claims 26 and 27 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have amended the claims to clarify the two independent dimming movements as requested by the Examiner. Applicants request that the Examiner withdraw the rejection.

Rejections under 35 U.S.C. § 103

**I. Walthall**

In the Office Action, the Examiner rejected claims 1-8, 23, 26, and 27 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 4,305,006 to Walthall (hereinafter Walthall). Applicants respectfully traverse.

As requested by the Examiner, Applicants have amended the claims to further distinguish from Walthall. Claim 1 has been amended to further clarify that the first and second electrical states correspond to **electrical on and off states** respectively. The dimming functionality of Walthall therefore does not teach or suggest (in any orientation) a device consistent with claim 1. And as discussed below and in previous responses, there is no suggestion or motivation in Walthall to further constrain the electrical **detection or response** characteristics in a manner consistent with the present invention.

In addition, as request by the Examiner, claim 1 has been amended to include the word “ONLY” to further clarify the distinction between the claimed inventions and the cited patents. This amendment further emphasizes the fact that the switch responds in a manner “which corresponds to only how a conventional toggle switch would respond to the detected movement”. Neither Walthall nor Endruschat alone or in any combination teach or suggest this limitation.

For at least these reasons, Applicants respectfully request that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. 103(a). Claims 2-8, 23, 26, and 27 are dependent from claim 1 and are therefore allowable for at least the same reasons.

## **2. Walthall + Lang**

In the Office Action, the Examiner rejected claims 9 and 24 under 35 U.S.C. 103(a) as being unpatentable over Walthall in view of U.S. Pat. No. 5,977,878 to Lang (hereinafter Lang). Applicants respectfully traverse. Claims 9 and 24 are dependent from claim 1 and are therefore allowable for at least the same reasons.

## **3. Endruschat + Walthall**

In the Office Action, the Examiner rejected claims 10-13 and 15-19 under 35 U.S.C. 103(a) as being unpatentable over Walthall in view of U.S. Pat. No. 5,594,238 to Endruschat (hereinafter Endruschat). Applicants respectfully traverse.

As requested by the Examiner, Applicants have amended the independent claims to further distinguish from Walthall. Claims 10 and 15 have been amended to further clarify that the first and second electrical states correspond to **electrical on and off states** respectively. The dimming functionality of Walthall therefore does not teach or suggest (in any orientation) a device consistent with claims 10 and 15. And as discussed below and in previous responses, there is no suggestion or motivation in Walthall to further constrain the electrical **detection or response** characteristics in a manner consistent with the present invention.

In the Response to Arguments section of the Office Action on page 15, the Examiner states:

The Claim language recites “the switch comprising the motion detection element configured to detect two independent motions, wherein the movement characteristics includes ...”. Thus, the motions are not limited to only those set of narrow movement characteristics. The movement characteristics can include those characteristics and any other movements that mimic the motion. Office Action page 15.

Applicants respectfully disagree with this analysis. As discussed in the telephonic interviews, that fact that the movements characteristics may **include** other characteristics does not mean that it can include movements which are not consistent with the listed characteristics. For example, a movement may also include an audible characteristic. The inclusion of this additional characteristic does not change the original limitations of the listed characteristic and therefore does not broaden which acceptable movements.

In addition, as requested by the Examiner, Applicants have amended the claims to further distinguish from the combination of Walthall and Endruschat. Claims 10 and 15 have been amended to include the word “**ONLY**” to further clarify the distinction between the claimed inventions and the cited patents. This amendment further emphasizes the fact that the switch responds in a manner “which corresponds to only how a conventional toggle switch would respond to the detected movement”. Neither Walthall nor Endruschat alone or in combination teach or suggest this limitation.

In addition, as stated in the previous two Amendment and Responses, Walthall and Endruschat teach touchless switches that detect and respond to a broad set of movements which **may** include the narrow set of movements described in the claims. However, Walthall does not teach a touchless switch which **ONLY detects AND responds** to the mimicked movements of the type described in the claim (required to physically switch a conventional toggle switch AND mimicking the movement characteristics of duration, direction, and distance). By not selectively detecting and responding to these types of movements, the devices taught by Walthall and Endruschat **will respond to other movements** and therefore will NOT respond in a “manner which corresponds to **ONLY** how a conventional toggle switch would operate in response to the detected movement”.

On page 7 of the Office Action, the Examiner states, “it would be an obvious design choice to a person of ordinary skill in the art to modify the directional movements of Walthall to corresponds to those of a conventional dimmer in order to not confuse the user.” Applicants respectfully disagree with this analysis. The majority of Walthall is directed at controlling multiple loads; only one embodiment discusses a single load by separating the direction for dimming from the direction of switching. Applicant requests that the Examiner provide the motivation (within Walthall) for this obvious modification. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *In re John R. Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Any such suggestion must be found in the prior art, and not based on applicants disclosure. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). A clear and particular showing of the suggestion to combine is required to support an obviousness rejection under Section 103. *Id.*

For at least these reasons, Applicants respectfully request that the Examiner withdraw the rejections of claims 10 and 15 under 35 U.S.C. 103(a). Claims 11-13 and 16-19 are dependent from claims 10 and 15 respectively and are therefore allowable for at least the same reasons.

#### **4. Endruschat + Walthall + Lang**

In the Office Action, the Examiner rejected claims 14 and 20 under 35 U.S.C. 103(a) as being unpatentable over Walthall in view of Endruschat and further in view of Lang. Applicants respectfully traverse. Claim 14 and 20 are dependent from claim 1 and are therefore allowable for at least the same reasons described above and below.

## 5. Endruschat + Walthall

In the Office Action, the Examiner rejected claims 10-13, 18, and 19 under 35 U.S.C. 103(a) as being unpatentable over Walthall in view of Endruschat. Applicants respectfully traverse.

On page 9 of the Office Action, the Examiner states, “it would have been obvious to a person of ordinary skill in the art to have the system of Endruschat detect such as motion in order to not confuse the user who is already accustomed to performing the motions to use the conventional switch”. Applicants do not understand this comment. Applicants request that the Examiner provide a **motivation** (within the references) for these modifications and a citation for their foundation. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *In re John R. Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Any such suggestion must be found in the prior art, and not based on applicants disclosure. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). A clear and particular showing of the suggestion to combine is required to support an obviousness rejection under Section 103. *Id.*

As discussed above neither Walthall nor Endruschat alone or in **any combination** teach the limitations contained in independent claims 1, 10, or 15. For at least these reasons, Applicants respectfully request that the Examiner withdraw the rejection of claims 10 under 35 U.S.C. 103(a). Claims 11-13, 18, and 19 are dependent from either claim 10 or 15 and are therefore allowable for at least the same reasons.

## 6. Endruschat

In the Office Action, the Examiner rejected claims 1, 15-17, and 25 under 35 U.S.C. 103(a) as being unpatentable over Endruschat. Applicants respectfully traverse.

On page 11 of the Office Action, the Examiner states that it would be obvious to a person of ordinary skill in the art “to modify the motion to be upwards to turn the switch on and downwards to turn the switch off since the user would already be accustomed to those switching motions of a conventional switch”. Applicants do not understand this comment. The “motion” is not being modified, the switch is selectively responding to particular movements. In addition, there is motivation or explanation given as to why it is obvious to modify a touchless switch in a manner consistent with a physical switch. Applicants request that the Examiner cite a reference to support this statement. The Examiner further states, “it would have been obvious to a person of ordinary skill in the art to determine if the motion is performed in a direction that corresponds to a convention switch in order to not confuse the user who is already accustomed to performing the motions to use the conventional switch”. Applicants do not understand this comment. Applicants request that the Examiner provide a **motivation** (within the reference) for these modifications and a citation for their foundation. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *In re John R. Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Any such suggestion must be found in the prior art, and not based on applicants disclosure. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). A clear and particular showing of the suggestion to combine is required to support an obviousness rejection under Section 103. *Id.*

As discussed above neither Walthall nor Endruschat alone or in **any combination** teach the limitations contained in independent claims 1, 10, or 15. For at least these reasons, Applicants respectfully request that the Examiner withdraw the rejections of claims 1 and 15

under 35 U.S.C. 103(a). Claims 16-17 and 25 are dependent from either claim 1 or 15 and are therefore allowable for at least the same reasons.

**6. Endruschat + Walthall + Lang**

In the Office Action, the Examiner rejected claim 14 under 35 U.S.C. 103(a) as being unpatentable over Endruschat in view of Walthall and further in view of Lang. Applicants respectfully traverse. Claim 14 is dependent from claim 10 and is therefore allowable for at least the same reasons described above and below.

**7. Endruschat + Lang**

In the Office Action, the Examiner rejected claim 20 under 35 U.S.C. 103(a) as being unpatentable over Endruschat in view of Lang. Applicants respectfully traverse. Claim 20 is dependent from claim 15 and is therefore allowable for at least the same reasons described above and below.



### CONCLUSION

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call or email the undersigned.

DATED this \_\_\_\_24th\_\_ day of \_\_\_\_\_ March \_\_\_\_\_, 2006.

Respectfully submitted,

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